

REMARKS

Claims 1-38 are presently pending. Claims 8-38 have been withdrawn from further consideration as being directed to a non-elected invention. Claims 1, 2, 4 and 5 have been amended to no longer recite subject matter withdrawn from further consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to a non-elected invention. No new matter has been added.

Applicant reserves the right to prosecute the subject matter of any canceled, withdrawn or amended claim or any other unclaimed subject matter in one or more continuation, divisional or continuation-in-part applications.

I. The Restriction Requirement Under 35 U.S.C. § 121

Applicant confirms the election of Group 1, claims 1-7, drawn to compounds of Formulas I and II and the election of the species set forth at page 7 of the Office Action mailed on January 27, 2005 in connection with the present application.

The Examiner has further withdrawn additional subject matter from consideration. In particular, it appears that subject matter directed to compounds of formulas I and II wherein: Z is substituted or unsubstituted heteroaryl or substituted or unsubstituted heterocycle; R¹ is substituted or unsubstituted heteroaryl, substituted or unsubstituted heterocycloalkyl or any biohydrolyzable group; R²-R⁶ are substituted or unsubstituted heteroaryl, substituted or unsubstituted heterocycloalkyl or heteroaryloxy; or R⁷ is substituted or unsubstituted heteroaryl, substituted or unsubstituted heterocycloalkyl or heteroaryloxy has been withdrawn.

Accordingly, Applicant has amended claims 1, 2, 4 and 5 without prejudice to no longer recite withdrawn subject matter. Applicant reserves the right to prosecute the withdrawn subject matter in one or more continuation, divisional or continuation-in-part applications.

II. The Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1 and 7 are rejected under 35 U.S.C. 112, first paragraph, for being allegedly indefinite. In particular, the Examiner has stated that the term "biohydrolyzable group" recited in claim 1 is not defined in the specification so as to know the structures of the compounds that are included and/or excluded by the term and that the term "unit dosage form" recited in claim 7 is not defined in the specification so as to know the type of dosage

forms that are include and/or excluded by the term. The Examiner has invited Applicant to point out where in the specification the above terms are defined.

Although Applicant believes that the term “biohydrolyzable group” is indeed defined in the specification at least at page 15, paragraphs [0075] and [0076], claim 1 has been amended without prejudice to no longer recite the term “biohydrolyzable group” in view of the Examiner’s withdrawal of this subject matter from consideration. Applicant reserves the right to pursue subject matter directed to compounds of claim 1 wherein R¹ is any biohydrolyzable group in one or more continuation, divisional or continuation-in-part applications.

Accordingly, Applicant submits that the rejection of claim 1 under 35 U.S.C. 112, first paragraph, for reciting the term “biohydrolyzable group” is now moot and must be withdrawn.

The term “unit dosage form” is defined in the specification at least at page 56, paragraphs [0150]-[0152]. In particular, the specification at page 56, paragraph [0150] states that examples of dosage forms include tablets, caplets, capsules, cachets, troches, lozenges, dispersions, suppositories, ointments, cataplasms, pastes, powders, dressings, creams, plasters, solutions, patches, aerosols and gels. The specification further provides details regarding the active ingredients and/or carriers that the dosage forms can comprise at page 56, paragraphs [0151] and [0152]. Accordingly, Applicant submits that the term “unit dosage form” is clearly defined in the specification and that claim 7 satisfies the written description requirement of 35 U.S.C. 112, first paragraph.

In view of the above remarks, Applicant respectfully submits that the rejection of claim 7 under 35 U.S.C. 112, first paragraph, cannot stand and must be withdrawn.

III. The Objection to Claims 2-6

Claims 2-6 are objected to as being dependent upon a rejected base claim. For the reasons discussed above, Applicant submits that amended claim 1, from which claims 2-6 either directly or indirectly depend, is now in condition for allowance. Accordingly, Applicant respectfully submits that the objection to claims 2-6 cannot stand and must be withdrawn.

V. References B11, B14-B17 and C01

The Examiner has not considered references B11, B14-B17 or C01 because translations were not provided.

Accordingly, Applicant submits herewith an English language abstract for each of references B11 and B14-B17¹ and an English language translation of reference C01. Applicant further submits herewith a supplemental revised Form PTO-1449 listing references B11, B14-B17 and C01. Applicant respectfully requests that the Examiner review the English language abstracts provided for references B11 and B14-B17 and the English language translation provided for C01, and that each reference be made of record in the file history of the above-identified application.

V. Conclusion

Applicant respectfully requests that the above remarks be considered in the present application file. No fee is believed to be due in connection with this Response other than that due in connection with the Request to Correct Inventorship Under 37 C.F.R. § 1.48(a)(1) submitted herewith; however, in the event that any fee is due, please charge the required fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Anthony M. Insogna, Reg. No. 35,203

By: Michael J. Bruner, Reg. No. 47,458

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By: Michael J. Bruner (Reg. No. 47,458)

For: Anthony M. Insogna (Reg. No. 35,203)

JONES DAY
222 East 41st Street
New York, New York 10017
(858) 314-1130

¹ Per M.P.E.P. § 609, submission of an English language abstract may fulfill the requirement for a concise explanation for each non-English language document.